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Martin Josso

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EXAMINER

ALSTRUM ACEVEDO, JAMES HENRY

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1616

NOTIFICATION DATE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/717,523	Applicant(s) JOSSO, MARTIN	
	Examiner JAMES H. ALSTRUM ACEVEDO	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-27,29,30,32-55,57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-27, 29-30, 32-55, and 57-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 3-27, 29-30, 32-55, and 57-58 are pending. Applicants' previously cancelled claims 2, 28, 31, and 56. Applicants have amended claims 3-27, 29-30, 32-55, and 57-58. Receipt and consideration of Applicants' amended claim set, Dr. Josso's declaration filed under 37 CFR 1.132, and remarks/arguments submitted on December 6, 2007 are acknowledged. Any rejections or objections of record that have not been explicitly maintained herein are withdrawn per Applicants' claim amendments and/or persuasive arguments.

Specification

The incorporation of essential material in the specification by reference to an unpublished U.S. application, **foreign application or patent**, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f). Specifically, the instant specification incorporates by reference a variety of foreign patent documents (e.g. EP 0832642 or DE10162844) by reference to provide the definition for or examples of suitable derivatives of UV-screening agents [i.e. see paragraph [0030] in the PG-PUB of the instant application]. One of the U.S. patent documents listed in paragraph [0030] to provide this information contains no information whatsoever about UV-screening agents, but rather describes a device for passing an electric current between electrodes (i.e. U.S. Patent No.

4,367,390). It is unclear how a disclosure concerning a device for passing an electric current between electrodes is suitable for providing adequate disclosure of suitable examples of the variety of derivative alluded to in the instant specification or to provide definitions setting forth the metes and bounds of said derivatives. The only other U.S. patent document incorporated by reference regarding what constitutes suitable examples of the various derivatives alluded to in Applicant's specification is U.S. Patent No. 2,463,264, which is limited solely to the preparation of water-soluble benzimidazole compounds.

Response to Arguments

Applicant's arguments filed 12/6/07 have been fully considered but they are not persuasive. Applicants traverse the objection of the specification by alleging that they are not relying on the material in the incorporated foreign references to overcome the 112, 2nd rejection for the term "bisbenzoazolylys," which has been interpreted to be equivalent to the term, "bisbenzoazolyyl derivatives," but rather Applicants' state the foreign references were merely provided to demonstrate examples of what an ordinary skilled artisan would allegedly understand the term "bisbenzoazolylys" to encompass. This is unpersuasive, because (1) examples do not constitute a definition that sets forth clear metes and bounds for the term "bisbenzoazolylys" and (2) Applicants arguments hinge on the information in the improperly incorporated foreign references to overcome the 112, 2nd rejection; thus, Applicants are relying on the incorporated references to overcome a rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

The rejection of claims 12 and 41 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is maintained** for the reasons of record as set forth on page 4 of the office action mailed on November 30, 2005 and further explained below.

Response to Arguments

Applicant's arguments filed December 6, 2007 have been fully considered but they are not persuasive. Applicants have traversed the instant rejection by asserting that a person of ordinary skill in the art at the time of the instant invention would understand that the term "bisbenzoazolyis" includes the bis-benzoazolyis derivatives because said term has been used in 8 issued U.S. patents and is present in the claims of some of the cited 8 US patents. This argument is found unpersuasive, because each application is examined on its own merits and the US patents cited by Applicants are not the subject of the instant examination.

The rejection of claims 12-13, 21-22, 41-42, and 49-50 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is maintained** for the reasons of record, which have been restated below in amended form to reflect Applicants' claim amendments.

The claims 12, 21, 41, and 49 are indefinite because these refer to the derivatives of various classes of chemical compounds. The term derivative, in general, and/or how it may apply to the different classes of chemical compounds recited in the rejected claims is not defined in the specification. It is noted that Applicants refer, primarily to foreign patent documents, which are incorporated by reference, to allegedly set forth what is meant by said derivatives. It is also noted that several examples of these derivatives are given; however, examples are not definitions, because examples do not clearly set forth the metes and bounds of a term. The 10th edition of the Merriam-Webster's Collegiate Dictionary (Merriam-Webster Incorporated: Springfield, Massachusetts, 1993, pp 311) defines "derivative" as, "a chemical substance related structurally to another substance and theoretically derivable from it." For example, carbon dioxide could theoretically be derived from the combustion of camphor. Therefore, the definition of derivative in the Merriam-Webster Collegiate Dictionary does not shed light on what Applicants' intended for the meaning of the various derivatives of the various chemical classes of compounds recited in the above rejected claims.

The remaining claims are rejected for depending upon a rejected claim.

Response to Arguments

Applicant's arguments filed December 6, 2007 have been fully considered but they are not persuasive. Applicants have traversed that the term "derivative" is clear when read in light of the content of Applicant's disclosure and the ordinary skilled artisan would be able to ascertain the within a reasonable degree of certainty whether his/her conduct is within or outside the scope of Applicant's claims, as supported by *In re Borkowski*.

The Examiner respectfully disagrees with Applicant's assertion that the metes and bounds of the term derivative is clearly set forth in Applicant's specification and would be clearly discernible to an ordinary skilled artisan. Regarding the citation of "In re Borkowski", the Examiner is unsure which case law Applicants are citing because there are several cases that are uncovered upon a search of the case name "In re Borkowski" and Applicants have provided no further citation information aside from the case name. The instant rejection is maintained at this time.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The rejection of claims 1, 3-6, 9-18, 25, 29-30, 32-46, 53, and 58 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) in view of Fankhauser et al.

(US 2002/0155073) is **maintained** per the teachings/disclosures set forth on pages 5-6 and 10-11 of the office action mailed on November 30, 2005 and page 4 of the office action mailed on May 12, 2006. The reasons of record have been restated herein below for ease of reference.

Applicant Claims

Applicant claims (1) a device comprising (a) a reservoir confining at least one composition for protecting skin and/or hair against UV radiation and (b) means to place said composition under pressure, wherein the composition is in the form of a simple or complex emulsion and comprises in a cosmetically acceptable aqueous carrier (i) a photoprotective system capable of screening out UV radiation and (ii) spherical microparticles of porous silica.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Iijima discloses (1) a composition contained in a releasing container such as **an aerosol container or pump type-releasing container**, and used as being released from such releasing container, and (2) a releasing container product containing such composition (see column 1, lines 7-11), wherein the composition includes one of three types comprising a blending of **inorganic porous fine particles** (e.g. **silicic anhydride, i.e. silica**) and (1) carrying a chemical, disperse solution, acrylic acid polymer, and alkali; (2) carrying a chemical, disperse solution, and synthetic resin fine particles; (3) carrying a chemical, disperse solution, acrylic acid polymer, alkali, and synthetic resin fine particles. The chemical to be carried by the inorganic porous fine particles includes **ultraviolet blocker, antioxidant**, sunburn remedy, moisturizer, styptic, oil, and others. As disperse solution, **water**, alcohol, ether and other organic solvents may be used (abstract). A typical example of releasing means include **the aerosol mechanism and pump**

Art Unit: 1616

spray mechanism (column 4, lines 59-60). Iijima discloses that one, two, or more of the carried chemicals may be used by blending depending on the intended use (column 5, lines 24-31). Examples of ultraviolet blockers include **benzophenones derivatives, salicylate esters, and p-amino benzoic acid derivatives** (column 7, lines 15-27). Iijima discloses that the inorganic fine particles include metal oxides (**silica, titanium dioxide, iron oxide, zinc oxide,** and others) that are preferably **nearly spherical in shape** and present in the composition in amounts ranging from **0.01 to 60 weight %**. This range encompasses the stated ranges in claims 9 and 10. Iijima discloses that the **specific surface, pore volume, and particle size of the particles ranges from 20 to 800 m²/g, 0.01 to 1.50 ml/g, and 0.5-15 microns, respectively** (column 10 lines 2-3 and Table 1).

Fankhauser teaches mixtures of micronized organic **UV filters for preventing tanning and for lightening human skin and hair** and to their use in **cosmetic** and pharmaceutical formulations (i.e. sunscreen compositions) [0001]. These compositions are desirable for the **preservation of skin color after solar irradiation** [0003]. Fankhauser teaches suitable UV filters include **triazine derivatives, benzotriazole derivatives, cinnamic acid derivatives, camphor derivatives, para-aminobenzoic acid (PABA) and derivatives thereof, salicylates, benzophenones** and also other classes of substance known as UV filters [0007] with specific examples including **2,4,6-tris(diisobutyl-4'-aminobenzalmalonate)-s-triazine [0065], 2-ethylhexyl-4-methoxycinnamate [0099], and benzophenones-3 and -4 [0139]**. Fankhauser teaches that his invention can be used in the form of various cosmetic formulations, including for treating hair, such as shampoos, hair conditioners, hair care compositions, etc. [0248]. The cosmetic formulations taught by Fankhauser can be in one of various forms, including in the

Art Unit: 1616

form of liquid preparation such as water in oil (W/O), oil-in-water (OIW), oil-water-oil (O/W/O), water-in-oil in water (WIO/W), PIT, and other microemulsions [0250]. It is also noted that Fankhauser teaches the inclusion of inorganic micropigments, including ZnO and TiO₂ coated with either aluminum oxide or silicon dioxide (i.e. silica) [0259]. Microemulsions are obvious over emulsions.

***Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)***

Iijima lacks the teaching of species of UV-screening agents belonging to the group stated in claims 13 and 42, and regimes or regimens for UV-protecting skin and/or hair by spraying on an effective amount of a sunscreen composition. These deficiencies are cured by Fankhauser.

***Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)***

It would have been obvious to a person of ordinary skill in the art at the time of the instant invention to combine the teaching of Iijima and Fankhauser, because both inventors teach UV-protecting compositions comprising sunscreen agents and Fankhauser's compositions are specifically intended to prevent changes in skin color upon solar irradiation. A person of ordinary skill in the art at the time of the instant invention would have known that the term solar irradiation obviously encompasses ultraviolet (UV) radiation. It would also have been obvious to a skilled artisan to place a sunscreen composition in aerosol/non-aerosol containers, as taught by Iijima, and apply said compositions to a subject's skin and/or hair by spraying. A skilled artisan would have been motivated to use the a dispenser containing a composition resulting

from the combined teachings of Iijima and Fankhauser to protect against the damaging effects of UV-radiation on skin and hair, because Fankhauser teaches that his compositions, comprising UV filters, are intended to prevent skin color change resulting from solar irradiation, which includes UV radiation. A skilled artisan would have had a reasonable expectation of successfully using the combined teachings to obtain a sunscreen composition to prevent damage from UV-radiation, because both references teach cosmetic compositions comprising known UV filters/screening agents.

Response to Arguments

Applicant's arguments filed 12/6/07 have been fully considered but they are not persuasive. Applicants have traversed the instant rejection by arguing that (1) attacking Iijima individually and asserting that Iijima does not allegedly teach that surfactants can form emulsions and Iijima is deficient because it does not exemplify or allegedly does not fairly suggest emulsions comprising UV screening agents combined with porous microparticles of silica; (2) the rejection allegedly does not properly consider the following phrases: (i) "simple or complex emulsion, (ii) "photoprotective system capable of screening UV radiation" and (iii) "means to place said composition under pressure";) the rejection allegedly does not properly consider the following phrases: (i) "simple or complex emulsion, (ii) "photoprotective system capable of screening UV radiation" and (iii) "means to place said composition under pressure"; (3) insufficient reasons are allegedly provided for combining the cited references, aside from impermissible hindsight; (4) there is allegedly no expectation of success upon combination of the

cited references; and (5) Applicant's data provided in declaration form (i.e. secondary considerations) demonstrate unexpected results.

The Examiner respectfully disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant's traversal arguments addressing the cited combination of references are addressed below (i.e. arguments 2-5).

Regarding (2), this argument is unpersuasive, because these phrases have been accorded proper weight. Applicant's arguments to the contrary are Applicant's opinion and merely a point of disagreement, because these phrases have been properly considered.

Regarding (3), clear reasons for combining the references have been given and are deemed sufficient. Once again, it appears Applicant is merely expressing his disagreement with the Examiner's position. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Furthermore, Fankhauser provides ample motivation for combination by teaching the protection of skin and hair against the

Art Unit: 1616

damaging effects of UV-radiation, as well as to prevent skin color change resulting from solar irradiation, which includes UV radiation.

Regarding (4), the only technical argument made to this effect is the assertion that the cited combination does not explicitly state enhancement of SPF. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., enhancement of SPF) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding (5), Applicants have demonstrated an unexpected ~100% increase in SPF in comparison with a reasonable prior art composition by way of data provided in a 1.132 declaration. However, the declaration data is not commensurate in scope with what Applicant is claiming, because the independent claims are generic with regards to the UV screening system, which can comprise more than one UV screening agent and is not limited to benzophenone-3 as the screening agent, but rather could include other structurally divergent organic screening agents (see Applicant's claim 12 for example). Furthermore, it is unclear from Applicant's data whether the results obtained using benzophenone-3 would be representative of the large genus of UV screening agents, which include both organic screening agents as well as inorganic UV screening agents (e.g. ZnO). Applicant's invented formulation used in the side-by-side comparison appears to be a simple emulsion. It is unclear if the same or similar result would be observed for complex emulsions as well. Finally, it is unclear from Applicant's declaration data

Art Unit: 1616

whether the observed result would be observed upon incorporation of the emulsion into a larger composition as one of many ingredients in a cosmetic formulation.

The rejection of claims 1, 3-12, 14-25, 29-30, 32-41, and 47-52 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) in view of Torgerson et al. (U.S. Patent No. 6,458,906) **is maintained** per the disclosures/teachings set forth on pages 5-6 and 11-13 of the office action mailed on November 30, 2005 and pages 4-5 of the office action mailed on May 12, 2006.

Applicant Claims

Applicant's claims have been described above.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

The teachings of Iijima and Torgerson are of record. The teachings of Torgerson have been restated above in the instant office action. The teachings of Torgerson are restated herein below. Torgerson teaches **cosmetic** and pharmaceutical compositions containing dispersible thermoplastic elastomeric copolymers, for **hair styling** purposes, and for providing cosmetic and pharmaceutical compositions for **topical application to the skin** (abstract). Torgerson teaches that the hair care and topical skin compositions comprising copolymers of his invention can be formulated into a wide variety of product types, including **sunscreens** (column 14, lines 16-23). Torgerson teaches that cosmetically acceptable topical carriers include **hydro-alcoholic systems (i.e. aqueous) and oil-in-water emulsions** (column 16, lines 23-25).

Art Unit: 1616

Torgerson teaches that sunscreen agents are also useful in his inventions, including 3-(4-methylbenzylidene) camphor, titanium dioxide, zinc oxide, silica, iron oxide, and mixtures thereof (column 18, lines 5 and 19-21). Example XIX teaches an emulsion for topical skin application that provides protection from the harmful effects of ultraviolet radiation. Torgerson teaches that his invention may also include sunless tanning agents, including dihydroxyacetone, which can be used in combination with sunscreen agents (column 18, lines 52-56). Example XVII teaches a sunless tanning emulsion for topical skin application.

*Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)*

Iijima lacks the teaching of sunscreen compositions comprising at least one self-or artificial tanning agent, including dihydroxyacetone (DHA). This deficiency is cured by Torgerson.

*Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)*

It would have been obvious to a person of ordinary skill in the art at the time of the instant invention to combine the teachings of Iijima and Torgerson, because they both teach sunscreen compositions comprising silica, UV-sunscreens, metal oxides, and aqueous carriers. It would have been apparent to a skilled artisan that combination of the teachings of Iijima and Torgerson would have yielded a composition suitable to protect a person's skin from UV-radiation damage and that would also allow one to obtain the appearance of a tan, due to the presence of a sunless tanning agent (dihydroxyacetone), per Torgerson's teachings. A skilled

Art Unit: 1616

artisan would have had a reasonable expectation of successfully obtaining a viable sunscreen/self-tanning composition, because the combined art teaches compositions containing well known sunscreen and sunless tanning agents. The amount of self- or artificial tanning agents in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient needed to achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, the optimization of ingredient amounts would have been obvious at the time of applicant's invention.

Response to Arguments

Applicant's arguments filed 12/6/07 have been fully considered but they are not persuasive. Applicants have traversed the instant rejection based upon the same arguments that primarily attack the alleged deficiencies of Iijima and asserting the absence of a proper suggestion/motivation to combine the cited references or have an expectation of success, as well as Applicant's showing of unexpected results. The Examiner's position regarding these arguments is herein incorporated by reference. Concerning the rationalization for combining the teachings of Iijima and Torgerson, the combination is obvious per the similarity of the compositions taught by both references (i.e. both teach sunscreen compositions comprising silica, UV-sunscreens, metal oxides, and aqueous carriers) and there would be an expectation of success because the combination suggests the use of well-known UV screening agents as well as tanning agents, as UV screening agents and tanning agents, respectively. The use of a compound

Art Unit: 1616

in the manner it is indicated as being suitable in the prior art unquestionably would provide an ordinary skilled artisan with a reasonable expectation of success. Regarding Applicant's data, the rebuttal arguments of this showing of unexpected results are herein incorporated by reference. The instant rejection is deemed to remain proper.

The rejection of claims 26-27, 54-55, and 57 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) ("Iijima") in view of Torgerson et al. (U.S. Patent No. 6,458,906) ("Torgerson") as applied to claims 1, 3-12, 14-25, 29-30, 32-41, and 47-52 above, and further in view of Candau, D. (U.S. Patent No. 6,033,648) ("Candau") **is maintained** per the teachings set forth on pages 5-6 and 11-14 of the office action mailed on November 30, 2005 and pages 4-5 of the office action mailed on May 12, 2006.

Applicant Claims

Applicant claims a device as described above, wherein said composition further comprises at least one polymer of isophthalic acid or of sulfoisophthalic acid.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

The teachings of Iijima and Torgerson are of record and have been restated above in the instant office action. The teachings of Candau are of record are restated herein below.

Candau teaches topically applicable/dermatological compositions for persistent artificial tanning of human skin (abstract). Candau teaches cosmetic compositions additionally comprising at least one aqueous dispersion of film-forming polymer particles to improve the persistence of

Art Unit: 1616

coloration and water colorfastness on the skin. Examples of these film-forming polymers include polyesters prepared in known manner by polycondensation from monomers, such as, phthalic acid, isophthalic acid, diethylene glycol, cyclohexanedimethanol, and sulfoisophthalic acid. Candau teaches that one may also use copolymers based on isophthalate/sulfoisophthalate and more particularly copolymers prepared by condensation of diethylene glycol, cyclohexanedimethanol, isophthalic acid and sulfoisophthalic acid (column 7, lines 33-36; column 8, lines 63-64; and column 9, lines 5-8, 15-18, and 37-44).

*Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)*

Iijima lacks the teaching of polyesters and copolymers thereof, including ones derived from isophthalic acid or sulfoisophthalic acid.

*Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)*

It would have been obvious to combine the teachings of Iijima in view of Torgerson with the teachings of Candau because both teach cosmetic compositions comprising sunless tanning agents for topical application to the skin. A skilled artisan would have been motivated to combine the teachings of Candau with those of Iijima in view of Torgerson, because the film-forming polymers of Candau's compositions improve the persistence of coloration and water colorfastness on the skin. Therefore, a person of ordinary skill would have had a reasonable expectation of successfully obtaining a cosmetic sunscreen/sunless tanning composition, because

the combined art teaches known components used as UV-sunscreens and sunless tanning agents and which improve the persistence of color on the skin.

Response to Arguments

Applicant's arguments filed December 6, 2007 have been fully considered but they are not persuasive. Applicants have traversed the instant rejection by asserting that the addition of Candau fails to cures the previously alleged deficiencies of Iijima and Torgerson based upon the above cited traversal arguments. The Examiner's rebuttal arguments are the same and are herein incorporated by reference. Regarding the allegation of a lack of reasoning to combine Candau, the record clearly sets forth that an ordinary skilled artisan would have been motivated to modify the Iijima/Torgerson teachings to include the features of Candau's teachings, because the film-forming polymers of Candau's compositions improve the persistence of coloration and water colorfastness on the skin. Regarding Applicant's data, the rebuttal arguments of this showing of unexpected results are herein incorporated by reference. The instant rejection is deemed to remain proper.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

Art Unit: 1616

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The provisional rejection of claims 1, 3, 4, 9-12, 14-17, 30, 32-33, 38-41, and 43-46 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6-15, 29, and 30 of copending Application No. 10/365,653 (copending '653) **is withdrawn** because copending '653 has been abandoned.

Conclusion

Claims 1, 3-27, 29-30, 32-55, and 57-58 are rejected. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Alstrum-Acevedo whose telephone number is (571) 272-5548. The examiner can normally be reached on M-F, 9:00-6:30, with every other Friday off.

Art Unit: 1616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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